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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,252	03/19/2004	Peter Polick	401-205	7492
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HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER WILLIAMS, JAMILA O	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/804,252

Applicant(s)

POLICK, PETER

Examiner

Jamila O. Williams

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-11 and 19-32 is/are rejected.
- 7) ☒ Claim(s) 2,5,12-18,33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/24/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the closing means, recited in claim 20; visual aid device, recited in claim 23; writing implement, recited in claim 28; means for producing an audio or visual response, as recited in claim 31 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 4, 20,26-27 are objected to because of the following informalities:

In claim 4 there is a lack of antecedent basis for "said leaves".

Claims 26-27 depend from product claim 22, however the preamble of claims 26-27 recited "The method of claim 22".

Claim 20 depends from claim 16, however it should depend from Claim 19 to provide proper antecedent basis for the closing means.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3,4,6-10,25 are rejected under 35 U.S.C. 102(b) as being anticipated by 3,055,118 to Betancourt.

Betancourt discloses a book containing at least one removable panel (24) and at least one pocket-containing leaf (12) having a front and back wall. The front wall of the pocket comprising an outer surface comprising a first page and the back wall comprising an outer surface comprising a second page, wherein at least one of the pages comprises predefined indicia (fig 1, see image 14 for example) and at least one aperture (18). The panel (24) comprises at least one panel indicia field (area where indicia 30 is printed constitutes an indicia field) and the at least one aperture is

positioned in aligned relation to one of the panel indicia fields when the panel is inserted into the pocket (see figure 4), as recited in claim 1. The front and back walls being fastened to one another along reciprocal, facing perimeter sections of front and back walls (fig 1), as recited in claim 3.

Regarding claim 6, Betancourt discloses panel indicia disposed within at least one of the indicia fields (30).

Regarding claim 7, wherein the panel that is adapted to receive user-created panel indicia within the indicia field, the panel of Betancourt is inherently capable of receiving user created indicia thereon.

Regarding claim 8, Betancourt discloses that the panel comprises categorical indicia (Lesson 2, for example).

Regarding claims 9-10, Betancourt discloses the panel having a tabular section (26) comprising tabular indicia (English) that relates to a common theme.

Regarding claim 25, Betancourt discloses the method of introducing permutations into predefined indicia on a page comprising at least one aperture, the method comprising removing a panel having first panel indicia from a pocket in a pocket containing leaf and inserting a panel with second panel indicia into the pocket such that the indicia is viewable through the aperture (figure 4 shows the first panel with first indicia inserted into the pocket, column 2 lines 64-72 discloses that inserts of different languages can be inserted into any desired pocket or tongue- which satisfies the step of inserting a panel with second panel indicia into the pocket as claimed).

5. Claims 1,3-4,6,7,21,22,24 are rejected under 35 U.S.C. 102(b) as being anticipated by 5,141,253 to Rice.

Rice discloses a book containing at least one removable panel (41, in that the sheets 21 and 51 are not sealed along the top edge, the panel 41 is capable of being removed see figures 6-7) and at least one pocket containing leaf (formed by sheet 21 and 51). The front wall of the pocket comprising an outer surface comprising a first sheet and the back wall of the pocket comprising a second sheet (figs. 2 and 5). Rice discloses having predetermined indicia on at least one of the pages (see fig. 3) and at least one aperture (53), wherein the panel comprises at least one panel indicia field (areas where indicia 45 is located makes up an indicia field) and the aperture (53) is positioned in aligned relation to one of the panel indicia fields when inserted into the pocket (figs 3-4), as recited in claim 1.

Regarding claims 3-4, Rice discloses the front and back walls (21,51) are fastened directly to one another along reciprocal facing perimeter sections of the front and back walls (fig 5) and a spacer (64) is disposed between the front and back walls (fig 5 and col. 8 lines 45-68 of the specification).

Regarding claim 6, the panel (41) comprises panel indicia disposed within at least one of the indicia fields (indicia 45).

Regarding claim 7, the panel of Rice is inherently capable of receiving user-created panel indicia within at least one of the indicia fields.

Regarding claims 21-22 and 26-27, Rice discloses that the at least one page and the panel indicia comprises story-based predetermined indicia and indicia relating to

educational categories (in that the indicia of Rice tells a story and educates the user about a product, this indicia satisfies the requirement of being story based or relating to an educational category- i.e. English or reading).

Regarding claim 24, Rice further provides for the method of completing gaps in a predefined indicia on a page, comprising inserting a panel that has indicia into a pocket leaf comprising a spacer such that the panel indicia is viewable on the page through said aperture (fig 1-5).

6. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by 1,525,696 to Spencer. Spencer discloses a method of introducing permutation into predetermined indicia on a page having at least one aperture (14), the method comprising removing a panel that has first panel indicia (fig 4) from a pocket in a pocket containing leaf (10) and inserting a panel having second panel indicia (fig 5 and page 2 lines 76-84 of the specification) into the pocket such that the second panel indicia are viewable on the page through the aperture (fig 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rice in view of 6,244,628 to Muller. Rice discloses all of the elements of the claims including having a tabular portion on the panel (see tab 34). Rice does not however disclose having indicia on that tab. Muller teaches having tabs (100) with indicia thereon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaches of Muller to place indicia on a tab with the tab of Rice for the purpose of providing information to the user.
9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rice in view of 2,438,048 to Graham or 893,353 to McGill. Rice discloses all of the elements of the claims including having a spacer (64). Rice does not however disclose having a locking mechanism capable of securing the panel in the pocket. Both Graham and McGill teach having locking mechanisms (fig 1 to McGill and fig 3 to Graham show clips that attach to sheets for securing them into position- this satisfies the locking mechanism of applicant- to the degree claimed). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the locking mechanism of either McGill or Graham with the spacer of Rice for the purpose of securing the panel in the pocket.
10. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rice or Betancourt in view of 5,951,298 to Werzberger. Both Rice and Betancourt disclose all of the elements of the claims as applied to claim 1 above. Neither of these references however disclose having a closing means on the aperture. Werzberger teaches having closing means (flaps 22). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to use the closing means of Werberger with the apertures of Rice or Betancourt for the purpose of selectively displaying the indicia.

11. Claims 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rice or Betancourt in view of 5,447,439 to Nathanson. Neither Rice nor Betancourt disclose the indicia on the panel being invisible to the naked eye and having apertures having an visual aid device to reveal the invisible indicia. Nathanson teaches having a book with invisible indicia and having a window (39) for viewing the indicia (col. 4 lines 40-45 of the specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the indicia and visual aid device of Nathanson with the panels and apertures of Rice or Betancourt for the purpose of selectively displaying the indicia.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rice or Betancourt in view of 6,543,615 to Lake. Both Rice and Mayhew disclose all elements of the claims as applied to claim 1 above. Neither of these references however disclose having an assembly for holding a writing implement. Lake discloses an assembly (20) for holding a writing implement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the assembly of Lake with the book of Rice or Betancourt for the purpose of providing the user with the option to attach a writing implement to the book.

13. Claim 31,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Betancourt in view of 6,591,526 to Garrett. Betancourt discloses all of the elements of the claims as applied to claim 1 above. Betancourt does not however disclose having an audio or visual response means and wherein the audio or visual response is unique to each user initiated action selected from a set of defined user-initiated actions. Garrett teaches having a book (photo album) that includes pocket containing leaves (60,62) for receiving panels (photos) and having an audio means unique to each photo (based on the user activating different control buttons 84). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the audio means of Garrett with the book of Betancourt for the purpose of providing recording messages or information to the user of the book.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Betancourt in view of 2,944,356 to Anthon. Betancourt all of the elements of the claims as applied to claim 1 above. Betancourt does not however disclose having a spacer between the front and back walls of the pocket. Anthon teaches having a spacer the sheets of a pocket (col. 2 line 72 and col. 3 lines 1-7 of the specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the spacer of Anthon with the pocket of Betancourt for the purpose of spacing the sheets of the pocket such that the panels can be easier inserted and removed therefrom.

15. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Betancourt in view of Anthon and further in view of 1,099,188 to Mealand.

Betancourt as modified by Anthon discloses all elements of the claims as applied to claim 4 above. This combination does not however disclose a method of populating indicia fields with user-defined indicia without reference to the predefined indicia and inserting the panel comprising the user populated indicia into the pocket. Mealand teaches having indicia fields that can be populated with user-defined indicia (in blank spaces 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use this teaching by Mealand with the panels of Betancourt (as modified by Anthon) for the purpose of allowing the user to vary the lesson or story in the book.

Allowable Subject Matter

16. Claims 2,5,12-18,33-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Mon-Fri 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-3484. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JW 4/27/2006



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SUPERVISORY PATENT EXAMINER